

RECEIVED
CENTRAL FAX CENTER

A0000104-01-SMH

DEC 24 2003

OFFICIAL

IN THE UNITED STATES PATENT & TRADEMARK OFFICE

APPLICANT : Stephen Douglas Barrett, et al. EXAMINER : Shengjun Wang
SERIAL NO. : 10/031,149 ART UNIT : 1617
FILED : June 3, 2002 PAPER NO. :
FOR : Method for Treating Chronic Pain Using MEK Inhibitors

Response to Restriction Requirement Under 35 U.S.C. 121 and 372

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

This is in response to the Office Action dated October 3, 2003 in which Restriction was required under 35 U.S.C. 121 and 372.

Under PCT Rule 13.1 and in accordance with 37 CFR 1.499, Applicants were required to elect a single invention of the following inventions:

Group I, claim(s) 1-31, drawn to a method of treating pain by using the compounds with formula (I), wherein the W is tetraazole (formulae viii and xvii).

Group II, claim(s) 1-31, drawn to a method of treating pain by using the compounds with formula (I), wherein the W is triazole (formulae ix, x, xi, and part of i).

Group III, claim(s) 1-31, drawn to a method of treating pain by using the compounds with formula (I), wherein the W is diazole (formulae ii, iii, part of iv, xii, xiii, xiv).

Group IV, claim(s) 1-31, drawn to a method of treating pain by using the compounds with formula (I), wherein the W is oxazole (formulae v, vi, and part of iv, xii, xiii).

Group V, claim(s) 1-31, drawn to a method of treating pain by using the compounds with formula (I), wherein the W is thiazole (part of formulae iv, xii, xiii, xiv).

10/031,149

-2-

A0000104-01-SMH

Group VI, claim(s) 31-32, drawn to a method of treating pain by using the compounds with formula (I), wherein the W is not a heterocyclic moiety.

Group VII, claim(s) 1-31, drawn to a method of treating pain by using the compounds with formula (I), wherein the W is a heterocyclic moiety other than those defined in groups I-V.

The Applicants hereby elect Group VII for prosecution on the merits, without traverse.


The Applicants have also been required to elect a single species to which the claim shall be restricted if no generic claim is finally held to be allowable. The Applicants hereby elect the species (2,3-Difluoro-6-[1,3,4]oxadiazol-2-yl-phenyl)-(4-iodo-2-methyl-phenyl)-amine. Claims 1-9, 11, 14, 20, 23, and 32 are readable on the elected species.

Finally, the Applicants respectfully reserve the right to file a Divisional application(s) to the non-elected claims.

The Applicants submit that this application is now in condition for allowance, which allowance is respectfully solicited.

Respectfully submitted,

Dated: December 24, 2003


Suzanne M. Harvey
Registration No. 42,640
Warner-Lambert Company
2800 Plymouth Road
Ann Arbor, MI 48105
Telephone: (734) 622-2658
Facsimile: (734) 622-1553

Customer No. 28880

Confirm. No.: 8665

DEC 24 2003

Please type a plus sign (+) inside this box → ☒

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

PTO/SB/21 (8-98)
Approved for use through 09/30/2000. OMB 0661-0031
Patent and Trademark Office: U.S. DEPARTMENT OF COMMERCE

OFFICIAL

| | | | |
|---|----------------------|---------------------------------|-----------------|
| TRANSMITTAL FORM (to be used for all correspondence after initial filing) | Application Number | 10/031,149 | |
| | Filing Date | June 3, 2002 | |
| | First Named Inventor | Stephen Douglas Barrett, et al. | |
| | Group Art Unit | 1617 | |
| | Examiner Name | Shengjun Wang | |
| Total Number of Pages in This Submission | 5 | Attorney Docket Number | A0000104-01-SMH |

| ENCLOSURES (check all that apply) | | |
|--|---|--|
| <input checked="" type="checkbox"/> Fee Transmittal Form | <input type="checkbox"/> Assignment Papers (for an Application) | <input type="checkbox"/> After Allowance Communication to Group |
| <input type="checkbox"/> Fee Attached | <input type="checkbox"/> Drawing(s) | <input type="checkbox"/> Appeal Communication to Board of Appeals and Interferences |
| <input checked="" type="checkbox"/> Amendment / Response | <input type="checkbox"/> Licensing-related Papers | <input type="checkbox"/> Appeal Communication to Group (Appeal Notice, Brief, Reply Brief) |
| <input type="checkbox"/> After Final | <input type="checkbox"/> Petition Routing Slip (PTO/SB/69) and Accompanying Petition | <input type="checkbox"/> Proprietary Information |
| <input type="checkbox"/> Affidavits/declaration(s) | <input type="checkbox"/> Petition to Convert to a Provisional Application | <input type="checkbox"/> Status Letter |
| <input checked="" type="checkbox"/> Extension of Time Request | <input type="checkbox"/> Power of Attorney, Revocation Change of Correspondence Address | <input checked="" type="checkbox"/> Additional Enclosure(s) (please identify below): |
| <input type="checkbox"/> Express Abandonment Request | <input type="checkbox"/> Terminal Disclaimer | Certificate of Transmission under 37 CFR 1.8 |
| <input type="checkbox"/> Information Disclosure Statement | <input type="checkbox"/> Small Entity Statement | |
| <input type="checkbox"/> Certified Copy of Priority Document(s) | <input type="checkbox"/> Request for Refund | |
| <input type="checkbox"/> Response to Missing Parts/Incomplete Application | Remarks | |
| <input type="checkbox"/> Response to Missing Parts under 37 CFR 1.52 or 1.53 | | |

| SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT | |
|--|--------------------------|
| Firm or Individual name | Suzanne M. Harvey |
| Signature | <i>Suzanne M. Harvey</i> |
| Date | 12/24/03 |

| CERTIFICATE OF MAILING | |
|---|----------------|
| I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Assistant Commissioner for Patents, Washington, D.C. 20231 on this date: 12/24/03 | |
| Typed or printed name | Beth N. Gaines |
| Signature | |
| Date | 12/24/03 |

Burden Hour Statement: This form is estimated to take 0.2 hours to complete. Time will vary depending upon the needs of the individual case. Any comments on the amount of time you are required to complete this form should be sent to the Chief Information Officer, Patent and Trademark Office, Washington, DC 20231. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Assistant Commissioner for Patents, Washington, DC 20231.

Customer No. 28880

PTO/SB/17 (01-03)

Approved for use through 04/30/2003. OMB 0851-0032
U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

**FEE TRANSMITTAL
for FY 2003**

Effective 01/01/2003. Patent fees are subject to annual revision.

☐ Applicant claims small entity status. See 37 CFR 1.27**TOTAL AMOUNT OF PAYMENT (\$)** 420.00**Complete if Known**

| | |
|----------------------|--------------------------------|
| Application Number | 10/031,149 |
| Filing Date | June 3, 2002 |
| First Named Inventor | Stephen Douglas Barrett, et al |
| Examiner Name | Shengjun Wang |
| Art Unit | 1617 |
| Attorney Docket No. | A0000104-01-SMH |

METHOD OF PAYMENT (check all that apply)☐ Check ☐ Credit card ☐ Money Order ☐ Other ☐ None☒ Deposit Account:Deposit Account Number
Deposit Account Name

23-0455

Warner-Lambert Company LLC

The Commissioner is authorized to: (check all that apply)

☒ Charge fee(s) indicated below ☒ Credit any overpayments
☒ Charge any additional fee(s) during the pendency of this application
☐ Charge fee(s) indicated below, except for the filing fee to the above-identified deposit account.
FEE CALCULATION**1. BASIC FILING FEE**

| Large Entity | | Small Entity | | Fee Description | Fee Paid |
|--------------|----------|--------------|----------|------------------------|----------|
| Fee Code | Fee (\$) | Fee Code | Fee (\$) | | |
| 1001 | 750 | 2001 | 375 | Utility filing fee | |
| 1002 | 330 | 2002 | 165 | Design filing fee | |
| 1003 | 520 | 2003 | 260 | Plant filing fee | |
| 1004 | 750 | 2004 | 375 | Reissue filing fee | |
| 1005 | 160 | 2005 | 80 | Provisional filing fee | |

SUBTOTAL (1) (\$) 0.00**2. EXTRA CLAIM FEES FOR UTILITY AND REISSUE**

| Total Claims | | Extra Claims | | Fee from below | | Fee Paid | |
|--------------------|------|--------------|---|----------------|--|----------|--|
| Independent | 20** | 0 | X | \$18.00 | | 0.00 | |
| Multiple Dependent | 3** | 0 | X | \$85.00 | | 0.00 | |
| | | | | 0.00 | | 0.00 | |

| Large Entity | | Small Entity | | Fee Description | Fee Paid |
|--------------|----------|--------------|----------|--|----------|
| Fee Code | Fee (\$) | Fee Code | Fee (\$) | | |
| 1202 | 18 | 2202 | 9 | Claims in excess of 20 | |
| 1201 | 84 | 2201 | 42 | Independent claims in excess of 3 | |
| 1203 | 280 | 2203 | 140 | Multiple dependent claim, if not paid | |
| 1204 | 84 | 2204 | 42 | ** Reissue independent claims over original patent | |
| 1205 | 18 | 2205 | 9 | ** Reissue claims in excess of 20 and over original patent | |

SUBTOTAL (2) (\$) 0.00

**or number previously paid, if greater; For Reissues, see above

FEE CALCULATION (continued)**3. ADDITIONAL FEES**

Large Entity Small Entity

| Fee Code | Fee (\$) | Fee Code | Fee (\$) | Fee Description | Fee Paid |
|----------|----------|----------|----------|--|----------|
| 1051 | 130 | 2051 | 65 | Surcharge - late filing fee or oath | |
| 1052 | 50 | 2052 | 25 | Surcharge - late provisional filing fee or cover sheet | |
| 1053 | 130 | 1053 | 130 | Non-English specification | |
| 1812 | 2,520 | 1812 | 2,520 | For filing a request for ex parte reexamination | |
| 1804 | 920* | 1804 | 920* | Requesting publication of SIR prior to Examiner action | |
| 1805 | 1,840* | 1805 | 1,840* | Requesting publication of SIR after Examiner action | |
| 1251 | 110 | 2251 | 55 | Extension for reply within first month | 420.00 |
| 1252 | 410 | 2252 | 205 | Extension for reply within second month | |
| 1253 | 930 | 2253 | 465 | Extension for reply within third month | |
| 1254 | 1,450 | 2254 | 725 | Extension for reply within fourth month | |
| 1255 | 1,970 | 2255 | 985 | Extension for reply within fifth month | |
| 1401 | 320 | 2401 | 160 | Notice of Appeal | |
| 1402 | 320 | 2402 | 160 | Filing a brief in support of an appeal | |
| 1403 | 280 | 2403 | 140 | Request for oral hearing | |
| 1451 | 1,510 | 1451 | 1,510 | Petition to institute a public use proceeding | |
| 1452 | 110 | 2452 | 55 | Petition to revive - unavoidable | |
| 1453 | 1,300 | 2453 | 650 | Petition to revive - unintentional | |
| 1501 | 1,300 | 2501 | 650 | Utility issue fee (or reissue) | |
| 1502 | 470 | 2502 | 235 | Design issue fee | |
| 1503 | 630 | 2503 | 315 | Plant issue fee | |
| 1460 | 130 | 1460 | 130 | Petitions to the Commissioner | |
| 1807 | 50 | 1807 | 50 | Processing fee under 37 CFR 1.17(q) | |
| 1806 | 180 | 1806 | 180 | Submission of Information Disclosure Stmt | |
| 8021 | 40 | 8021 | 40 | Recording each patent assignment per property (times number of properties) | |
| 1809 | 750 | 2809 | 375 | Filing a submission after final rejection (37 CFR 1.129(a)) | |
| 1810 | 750 | 2810 | 375 | For each additional invention to be examined (37 CFR 1.129(b)) | |
| 1801 | 750 | 2801 | 375 | Request for Continued Examination (RCE) | |
| 1802 | 900 | 1802 | 900 | Request for expedited examination of a design application | |

Other fee (specify)

*Reduced by Basic Filing Fee Paid

SUBTOTAL (3) (\$) 420.00**SUBMITTED BY**

Name (Print/Type) Suzanne M. Harvey

Registration No. 42,640

(Complete if applicable)

Telephone 734-622-2658

Signature

Suzanne M. Harvey

Date Dec 24, 2003

WARNING: Information on this form may become public. Credit card information should not be included on this form. Provide credit card information and authorization on PTO-2038.

This collection of information is required by 37 CFR 1.17 and 1.27. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.14. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, Washington, DC 20231. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, Washington, DC 20231.

A0000104-01-SMH

PTO/SB/97 (08-03)

Approved for use through 07/31/2006. OMB 0851-0031

U.S. Patent and Trademark Office: U.S. DEPARTMENT OF COMMERCE

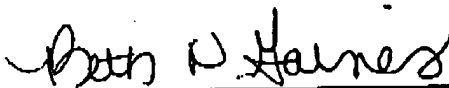
Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it contains a valid OMB control number.

Certificate of Transmission under 37 CFR 1.8

I hereby certify that this correspondence is being facsimile transmitted to the United States Patent and Trademark Office to 1-703-872-9306,

on December 24, 2003

Date



Signature

Beth N. Gaines

Typed or printed name of person signing Certificate

Note: Each paper must have its own certificate of transmission, or this certificate must identify each submitted paper.

No. of Pages **5**

Return Fax No.: 734-622-1553

This collection of information is required by 37 CFR 1.8. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.14. This collection is estimated to take 1.8 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.